

Remarks

Claims 1-18 are pending in the application. Claims 1 and 10 are rejected, while claims 2-9 and 11-18 are objected to. Based on the following, reconsideration of the rejected claims is respectfully requested.

Claim Rejections - 35 U.S.C. § 102

The Examiner rejected claims 1 and 10 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,425,365 (Peters et al.). The Examiner states that Peters et al. discloses an apparatus and method for shutdown of a hybrid electric vehicle, wherein an evaporative emissions control system and an EGR valve are disabled at the time of engine shutdown. The Examiner specifically references the abstract and Figure 3 of Peters et al.

Applicants thank the Examiner for the telephonic interview conducted on October 1, 2003. During the interview, the rejection of claims 1 and 10 and the Peters et al. reference were discussed. Applicants submitted that Peters et al. was not properly relied upon for a 35 U.S.C. § 102(e) rejection since the joint inventors of the present application are exactly the same as the joint inventors of Peters et al. The Examiner disagreed, but said that the rejection could be overcome by filing an Affidavit under 37 C.F.R. § 1.132 asserting that the subject matter disclosed in Peters et al. was the invention of the Applicants. The interview was then concluded.

Applicants respectfully traverse the rejections to claims 1 and 10, maintaining that Peters et al. is not properly relied upon as a 35 U.S.C. § 102(e) prior art reference. The statute itself says that to qualify as a reference under § 102(e), the invention must be described in "a patent granted on an application for patent by *another* filed in the U.S. before the invention by the applicant for patent...." 35 U.S.C. § 102(e)(2) (emphasis added). The Peters et al. patent application was not filed by another; it was filed by the *same four inventors* that filed the present application. Therefore, the Peters et al. reference does not qualify as prior art under 35 U.S.C. § 102(e).

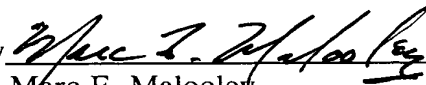
This position is supported by the MPEP, which states that a patent reference *cannot be used against an applicant* where the applicant is the patentee, and the patent issued less than one year prior to the filing date of the application. MPEP § 716.10, 8th ed., Rev. 1 (example 1). In addition, Applicants submit that the declarations filed with the application for Peters et al. and the present application provide evidence of the common inventorship. Therefore, based on the plain words of the patent statute, and the MPEP, Applicants submit that the Peters et al. reference is not properly relied upon, and that claims 1 and 10 are allowable.

Allowable Subject Matter

The Examiner objected to claims 2-9 and 11-18 as being dependent upon a rejected base claim. As discussed above, claims 1 and 10 are believed to be allowable; Applicants therefore submit that the objections to claims 2-9 and 11-18 are overcome. Accordingly, allowance of claims 1-18 is requested.

Respectfully submitted,

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Date: October 13, 2003

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